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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Biological & Popular Culture, Inc.

Serial No. 75/399,471

William H. Murray and Robert E. Rosenthal of Duane, Morris & Heckscher for applicant.

Gregory A. Fosdick, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Walters, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Biological & Popular Culture, Inc. has filed a trademark application to register on the Principal Register the mark HEALTHCARE INTELLECTUAL PROPERTY MANAGEMENT for the following services:[1]

> Procurement services, namely, purchasing supplies and equipment for physicians and medical and clinical laboratories; management of medical and clinical laboratories for others; management of group purchasing organizations and associations of health care providers; pharmacy benefit plan management for others; order fulfillment for pharmacies; automated inventory control; inventory management; secretarial

[1] Serial No. 75/399,471, filed December 3, 1997, based on an allegation of a bona fide intention to use the mark in commerce.

and clerical services, namely, scheduling appointments for health care professionals; business consultation services for physicians, medical and clinical laboratories, and health care preferred provider organizations; billing and accounting services; bookkeeping; personnel management; personnel placement and recruitment; providing statistical information regarding the effectiveness of particular medical treatments; data processing services; market research of health care, pharmaceutical and medical devices; business marketing consulting and advertising agencies for the health care, pharmaceutical, medical device, medical laboratory and medical supply fields; telemarketing; distributorship and mail order catalog services featuring pharmaceuticals, injectables, vaccines, medical equipment and medical disposables; business records management services; business information concerning sources of pharmaceutical products; facilities management services for physicians' offices; data processing services; business consultation services in the field of real estate,[2] in International Class 35; and

Design and provision for others of healthcare services in the nature of patient wellness, behavior modification and management, and compliance programs; medical and clinical laboratories; medical examination services rendered via telecommunications to underwriters; clinical medical research; maintaining files and records concerning the medical condition of others; computer programming for others; association services to promote the interests of physicians; providing information pertaining to medicine and medical practice for remote access by computer; design of computer systems and computer software for medical and clinical laboratories; consultation regarding computer hardware, software and systems; consultation in the field of medical records; medical consultation, namely measuring and determining outcomes of patient care; medical and clinical laboratory consultation services; rental of medical and clinical laboratory equipment, in International Class 42.

[2] The recitation of services in the application as originally filed did not contain "business consultation services in the field of real estate." Should applicant ultimately prevail in this appeal, the file should be remanded to the Examining Attorney to consider this expansion of the scope of the recitation of services.

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its proposed services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that "applicant's services are exactly the type of services a consumer would expect from a healthcare intellectual property management business"; that "applicant manages business information and offers other services which are protected by or subject to intellectual property law"; and that applicant "manages this intellectual property for clients in the healthcare industry."

In support of his position, the Examining Attorney submitted definitions of "intellectual property" from *McCarthy's Desk Dictionary of Intellectual Property* (2nd ed. 1995) as, *inter alia*, "[patent-trademark-unfair competition-copyright-trade secret-moral rights] Certain creations of the human mind that are given the legal aspects of a property right"; and from *The American Heritage Dictionary of the English Language* (3rd ed. 1992)

as "*Law.* Property that results from original creative thought, as patents, copyright material, and trademarks." He submitted a definition of "trade secret," also from *McCarthy's*, supra, as "business information that is the subject of reasonable efforts to preserve confidentiality and has value because it is not generally known in the trade." Additionally, the Examining Attorney submitted excerpts of articles from the LEXIS/NEXIS database that include uses of "intellectual property management" as a term of art referring, across a variety of fields of business, to the management of a company's intellectual property.[3]

Applicant, conceding that the terms HEALTHCARE and MANAGEMENT are merely descriptive in connection with the recited services,[4] contends that the term INTELLECTUAL

[3] A number of the excerpts are from either newswire services or from foreign publications. Newswire stories are of minimal evidentiary value because it is not clear that such stories have appeared in any publication available to the consuming public. *See, In re Manco Inc.,* 24 USPQ2d 1938 (TTAB 1992); and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986). Similarly, articles in foreign publications are of minimal value, as we have no evidence concerning possible circulation in the United States from which to infer the possible impact on the perceptions of the relevant public in this country. *See, In re Men's International Professional Tennis Council*, *supra*. However, there are sufficient excerpts in the record from U.S. publications to support our conclusion regarding the connotation of the term "intellectual property management."

[4] Applicant suggests that it may be willing to enter a disclaimer of HEALTHCARE and MANAGEMENT; however, as no disclaimer has been required by the Examining Attorney or submitted by applicant, that issue is not before us.

PROPERTY is, at most, suggestive in connection therewith.[5] Applicant states that "such items as improved purchasing of supplies and equipment would not constitute property in the literal sense, and certainly not intellectual property, improvements in such areas improves operations and therefore suggests an asset of a business." Regarding the mark HEALTHCARE INTELLECTUAL PROPERTY MANAGEMENT, applicant states that "when linked to Applicant's services [the mark] suggests the ability of Applicant to harness knowledge about the healthcare field to provide services in new and innovative ways [and] hints at Applicant's substantial resources of current information, and access to new information, regarding the health care field."

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Bright-Crest, Ltd.*, 204

[5] We note applicant's co-pending application Serial No. 75/399,472, for the mark BIOPOP BIOLOGICAL & POPULAR CULTURE, INC. HEALTHCARE INTELLECTUAL PROPERTY MANAGEMENT, for many of the same services included herein, includes a disclaimer of the entire phrase HEALTHCARE INTELLECTUAL PROPERTY MANAGEMENT. A notice of allowance has issued in that case. While applicant appears to have admitted the descriptiveness of that phrase in connection with the services recited in that application, that record is not before us in this case.

USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re Recovery*, 196 USPQ 830 (TTAB 1977).

Applicant's recited services include such services as "management of medical and clinical laboratories for others," "management of group purchasing organizations and association of health care providers," "market research of health care, pharmaceutical and medical devices," "business marketing consulting and advertising agencies for the health care, pharmaceutical, medical device, medical laboratory and medical supply fields," "design and provision for others of healthcare services …," and a

variety of consultation services for the medical field. Clearly, applicant's services pertain, principally, to the healthcare field. Further, the recited services are so broad as to encompass all aspects of management and consultation to applicant's relevant consumers, *i.e.*, healthcare professionals and organizations, medical laboratories and pharmaceutical and medical device companies, including the development and management of intellectual property, and related marketing and promotion.

The term "intellectual property," as defined by the dictionary definitions of record, and the term "intellectual property management," as evidenced by the excerpted articles, would be clearly understood by business, medical and healthcare professionals as these terms have been defined and used in this record. We find it highly unlikely that such terminology would be perceived, rather, as suggestive of applicant's knowledge, resources and innovations in the healthcare field.

In the present case, it is our view that, when applied to applicant's services, the term HEALTHCARE INTELLECTUAL PROPERTY MANAGEMENT immediately describes, without conjecture or speculation, a significant feature or function of applicant's proposed services, as discussed herein. Nothing requires the exercise of imagination,

cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term HEALTHCARE INTELLECTUAL PROPERTY MANAGEMENT as it pertains to applicant's recited services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.

C. E. Walters

B. A. Chapman

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board